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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/931,449	08/16/2001	Santosh S. Arcot	215063.02901.	2650
35617	7590	03/03/2005	EXAMINER	
DAFFER MCDANEIL LLP			LU, FRANK WEI MIN	
P.O. BOX 684908			ART UNIT	
AUSTIN, TX 78768			PAPER NUMBER	

1634

DATE MAILED: 03/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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Advisory Action Before the Filing of an Appeal Brief	Application No. 09/931,449	Applicant(s) ARCOT, SANTOSH S.	
	Examiner Frank W. Lu	Art Unit 1634	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 31 January 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
 b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The reply was filed after the date of filing a Notice of Appeal, but prior to the date of filing an appeal brief. The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
 (a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
 (b) ☐ They raise the issue of new matter (see NOTE below);
 (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
 5. ☐ Applicant's reply has overcome the following rejection(s): _____.
 6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
 7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
 The status of the claim(s) is (or will be) as follows:
 Claim(s) allowed: _____.
 Claim(s) objected to: _____.
 Claim(s) rejected: 3, 5-29, 35 and 36.
 Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
 9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
 10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☐ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
 12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____.
 13. ☐ Other: _____.

DETAILED ACTION

Advisory Action

1. The proposed amendments filed on January 31, 2005 have been fully considered but will not be entered because they raise new issues that would require further consideration and/or search.

Response to Arguments

I. In page 10, second to fourth paragraphs of applicant's remarks, applicant argues that the final rejection is improper since the amendments to the claims presented in the prior response were made to correct antecedent problems and other informalities in the claims and did not necessitate new grounds of rejection. In addition, the new grounds of rejection are not based on information submitted in an information disclosure statement.

These arguments have been fully considered but they are not persuasive toward the withdrawal of the rejection. Since applicant was amended the phrase "the sample is suspected of containing one or more first and one or more second target nucleic acid sequences" in claims 3 and 5 to "one or more target nucleic acid sequence comprise one or more first and one or more second target nucleic acid sequences" in the amendment filed on July 21, 2004, the amendment filed on July 21, 2004 required that one or more target nucleic acid sequence must comprise one or more first and one or more second target nucleic acid sequences. However, the amendment filed on November 24, 2003 did not require that one or more target nucleic acid sequence must comprise one or more first and one or more second target nucleic acid sequences. Thus the scope of claims 3 and 5 filed on July 21, 2004 has been changed and the amendments to the claims presented in the prior response were not made to only correct antecedent problems. Based on scope change of claims 3 and 5, the rejection under USC 102 (e) based on the patent of Chee

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et al., was withdrawn and the new grounds of rejection on claims 3, 5, 7, and 9 were used in the final rejection. Therefore, applicant's amendment necessitated the new ground(s) of rejection presented in this Office action and the final rejection is proper.

II. In page 11, first paragraph of applicant's remarks, applicant argues that the proposed amendment on claim 10 has overcome the objection.

This argument has been fully considered but it is not persuasive toward the withdrawal of the rejection because applicant's argument with respect to claim 10 is moot since applicant has amended claim 56.

III. In page 12, second paragraph of applicant's remarks, applicant argues that the proposed amendments on claims 5, 10, 15, 17, 20, 22, 23, and 24 have overcome the rejections under 35 USC 112, second paragraph.

This argument has been fully considered but it is not persuasive toward the withdrawal of the rejection because applicant's arguments with respect to claims 5, 10, 15, 17, 20, 22, 23, and 24 are moot since applicant has amended claim 56. The proposed amendments in claims 5, 10, 15, 17, 20, 22, 23, and 24 raise new issues that would require further consideration and/or search. For example, an additional subset of bound probes recited in claims 15 and 23 and an additional subset of free probe recited in claims 20 and 24 are new limitations and are not found in claims 15, 20, 23, and 24 filed on July 21, 2004.

IV. In page 11, third paragraph bridging to page 12, last paragraph of applicant's remarks, applicant's argues that Barany *et al.*, do not teach ligating hybridized free probes with hybridized spectrally addressable bound probes.

This argument has been fully considered but it is not persuasive toward the withdrawal of

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the rejection. Since, in US 2003/0022182, Barany *et al.*, teach to ligate a fluorescence-labeled probe to its adjacent fluorescently labeled probe in the presence of a target nucleic acid (see page 6, [0080] and page 7, [0087]) with an addressable array-specific portion (see page 34, claim 1) that can bind to an addressable array comprising a support, Barany *et al.*, teach ligating hybridized free probes with hybridized spectrally addressable bound probes. Since, in US 2003/0032016, Barany *et al.*, teach to ligate an allele-specific probe to its adjacent fluorescently labeled common probe in the presence of a target nucleic acid with an addressable array-specific portion (see page 10, [0109] and [0110]) that can bind to an addressable array comprising a support, Barany *et al.*, teach ligating hybridized free probes with hybridized spectrally addressable bound probes.

V. In page 13, first paragraph bridging to page 14, second paragraph of applicant's remarks, applicant argues that: (1) "[C]hee, however, does not disclose ligating hybridized free probes with hybridized spectrally-addressable bound probes"; and (2) "[C]hee does not teach that bound OLA primer 45 is spectrally-addressable".

These arguments have been fully considered but they are not persuasive toward the withdrawal of the rejection because Chee *et al.*, teach that bound probes (ie., a first OLA primer 45) of the at least one subset of bound probes comprise a microsphere and an oligonucleotide probe wherein the oligonucleotide probes comprise an oligonucleotide at a first end of the oligonucleotide probes having a modifier moiety (ie., amino groups, see column 43, last paragraph bridging to column 44, first paragraph) which is used for coupling the oligonucleotide probe to the microsphere (see column 43) and wherein the oligonucleotide probe further comprises an oligonucleotide having a predetermined nucleotide sequence that is complementary to at least another portion of the target nucleic acid molecules (see Figure 7B), and the

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microspheres of bound probes of the least one subset of bound probes having an unique spectral address or an unique fluorescence dye which allows one to distinguish the microspheres of different subsets of the at least one subset of bound probes (see columns 44 and 45), Chee *et al.*, disclose ligating hybridized free probes with hybridized spectrally-addressable bound probes and teach that bound OLA primer 45 is spectrally-addressable (ie., fluorescence labeled).

VI. In page 14, third paragraph bridging to page 16, first paragraph of applicant's remarks, applicant argues that: (1) Barany *et al.*, do not teach ligating hybridized free probes with hybridized spectrally addressable bound probes as recited in claims 3 and 5; and (2) Kwok *et al.* and Church *et al.*, cannot overcome the deficiencies of Barany *et al.*.

These arguments have been fully considered but they are not persuasive toward the withdrawal of the rejection because US 2003/0022182 from Barany *et al.*, teach all limitations recited in claims 3, 7, and 9 while US 2003/0032016 taught by Barany *et al.*, teach all limitations recited in claim 5 (see Response to Arguments in IV) and Kwok *et al.* and Church *et al.*, are used to reject claims 6 and 8.

2. Papers related to this application may be submitted to Group 1600 by facsimile transmission. Papers should be faxed to Group 1600 via the PTO Fax Center. The faxing of such papers must conform with the notices published in the Official Gazette, 1096 OG 30 (November 15, 1988), 1156 OG 61 (November 16, 1993), and 1157 OG 94 (December 28, 1993)(See 37 CAR § 1.6(d)). The CM Fax Center number is (571)273-8300.

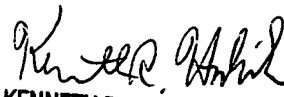
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frank Lu, Ph.D., whose telephone number is (571)272-0746. The examiner can normally be reached on Monday-Friday from 9 A.M. to 5 P.M.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, W. Gary Jones, can be reached on (571)272-0745.

Any inquiry of a general nature or relating to the status of this application should be directed to the Chemical Matrix receptionist whose telephone number is (703) 308-0196.

Frank Lu
PSA
February 28, 2005


KENNETH R. HORLICK, PH.D.
PRIMARY EXAMINER

3/1/05